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10/633,209	07/31/2003	Peter Toop	GJE-7134	3280

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EXAMINER

MATTHEWS, WILLIAM H

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/633,209
Filing Date: July 31, 2003
Appellant(s): TOOP, PETER

David R. Saliwanchik
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed February 21, 2008 appealing from the Office action mailed August 31, 2007.

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(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US 6,425,917 B1	BLAKE	6-2002
EP 0962196 A1	TOOP	8-1999

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5,7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toop EP 0962196 in view of Blake US PN 6425917.

Toop disclose an intraocular lens for placement in the capsular bag of the posterior chamber comprising two compressible haptics (3a, 3b) having multiple stages of compression (see Figures 3 and 4) and providing an elliptical shape when compressed (Figure 4). Toop lacks the express written disclosure of the optic being toric and the haptics having a distal part comprising a greater thickness. Toop do disclose thicker haptics are desirable in order to reduce trauma upon implantation (see paragraph 0017). Blake '917 teach in Figures 3A-3B an intraocular lens comprising a toric optic (col. 5 lines 55-57) and thicker, elastomeric, distal parts 300 on each haptic (Figure 3B) in order to treat patients in need of a toric optic, and to provide a more stabilized and atraumatic lens upon implantation in eye tissue (see col. 9 line 58 – col. 10 line 4). The lens of Toop is similarly disclosed for use in the capsular bag of the posterior chamber (col. 4 lines 50-54 and col. 5 lines 9-23), and Toop discloses the

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distal haptic region improvement may be applied to “any haptic of frame known by one of skill in the art”.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the intraocular lens disclosed by Toop '196 by including a toric optic and thicker distal parts on each haptic, as taught by Blake '917, in order to treat patients in need of a toric optic and provide a more stabilized and atraumatic lens upon implantation in eye tissue.

(10) Response to Argument

Appellant argues the Examiner fails to establish a prima facie case of obviousness because there was no apparent reason to combine Toop and Blake (Brief, page 2, paragraph 3). In support thereof, Appellant contends the following issues:

- 1) The lens of Toop is designed for the posterior chamber capsular bag and the lens of Blake is designed for the anterior chamber angle,
- 2) Blake provides no motivation or advantage to provide the “thicker haptic parts”,
- 3) A reasonable expectation of success would be lacking if the teachings of Toop and Blake were combined because each lens is purportedly designed for different regions of the eye, and
- 4) Hindsight reasoning is the only basis to combine the teachings of Toop and Blake because of issues 1) through 3) above.

Examiner respectfully disagrees with each of Appellant's arguments as set forth below.

With regard to issues 1) and 3), Examiner disagrees as Blake clearly disclose the lens designed for use in the anterior chamber angle, anterior chamber, posterior chamber, or capsular bag of the posterior chamber (see col. 4 lines 50-54, col. 5 lines 9-16, and col. 11 line 65 – col. 12 line 3). Therefore Applicant's basis for the combination of references lacking a reasonable expectation of success is unwarranted.

With regard to issue 2), Examiner disagrees because Blake discloses advantages of adding the elastomeric material to rigid haptics (via dip-coating col. 8 lines 48-58), thus making the distal region of the haptic thicker as shown in Fig. 3B. Blake repeatedly motivates one of ordinary skill in the art by teaching a non-irritating, softer atraumatic contact point (abstract and lines 63-65 of col. 4), long-term stability (abstract), shape maintenance (lines 58-61 of col. 4), and gentle atraumatic interaction with eye tissue (lines 65-67 col. 9). Blake further provides motivation by suggesting the improved haptic ends could be added to any haptic or frame known by one of skill in the art (lines 43-50 of col. 5). In addition, Toop describes the potential problem of tissue trauma caused by haptic distal parts upon implantation of a lens in the capsule, as well as a desire to provide thicker haptics (paragraph 0017). Therefore, a motivation to combine is in fact provided by both references.

With regard to issue 4), it is clear that the Examiner has not based the combination of Toop and Blake upon hindsight reasoning. The cited references, as a whole, teach all the limitations of claims 1-5 and 7 provide motivation for combining the teachings of Toop and Blake, and a reasonable expectation of success would be apparent to one of ordinary skill in the art.

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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/William H. Matthews/

Primary Examiner AU 3774

Conferees:

/Thomas Barrett/

TQAS TC 3700

/Corrine M McDermott/

Supervisory Patent Examiner, Art Unit 3738